Remarks/Arguments

Claims 1, 4, 6, 7 and 9 are pending in the present case. Claim 1 has been amended to more clearly claim the invention. No new matter has been added.

In the Office Action mailed February 25, 2004, the Examiner again rejected claims 1, 4, 7 and 9 are rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,239,183 to Farmer. Additionally, claims 1 and 6 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,239,183 to Farmer.

In response to the rejections applicant provides the following distinguishing remarks that are believed to place the present case in condition for allowance. Favorable reconsideration of all the pending claims is respectfully requested.

I. The Rejection of Claims 1, 4, 7 and 9 Under 35 U.S.C. §102(e) Over U.S. Patent No. 6,239,183 to Farmer.

In drilling operations, **fluid loss** is the leakage of the liquid phase of the drilling fluid, slurry and/or treatment fluid containing solid particles into the formation matrix. The resulting buildup of solid materials or filter cake is undesirable, as is the penetration of filtrate through the formation. Fluid loss additives are employed to **control this process of fluid loss** and **avoid the potential reservoir damage** that could result there from.

Independent claim 1 is directed to a **method for controlling the fluid loss** in a subterranean formation, thereby minimizing the potential damage to the formation caused by said fluid loss. The method comprises **treating the formation** with a **viscoelastic treating fluid** having:

an aqueous base fluid; and

one or more non-ionic amido amine oxide surfactant gelling agents of the invention;

injecting the aqueous viscoelastic surfactant treating fluid through a wellbore and into the subterranean formation; and treating the subterranean formation under conditions effective to do so, and

breaking the gel of the aqueous viscoelastic treating fluid subsequent to treating said formation.

Applicant respectfully submits that in order to support a rejection under 35 U.S.C. §102, the examiner must cite a single prior art reference that discloses each and every limitation of the claim. Farmer clearly does not meet this requirement, inherently or otherwise.

Farmer discloses a viscoelastic surfactant that can be employed in applicant's method. This disclosure clearly does not, however, render applicant's **NEW method of use** unpatentable. If this were the case...then one would NEVER be able to patent a "new" use for an old composition.

Further, claim 1, as amended, is directed to a **method for controlling the fluid loss** in a subterranean formation, thereby minimizing the potential damage to the formation caused by said fluid loss. Farmer does not disclose a method for controlling fluid loss.

The claimed method comprises **treating** said subterranean formation with a viscoelastic treating fluid, wherein said fluid further comprises **a salt or solid**; and mixtures thereof. The specifics of this treating fluid and/or method are clearly not disclosed.

Additionally, the present claims require the **step of breaking the gel** of the aqueous viscoelastic treating fluid subsequent to treating said formation. This claim feature is also not disclosed by the cited art.

Finally, the examiner alleges that the fluids of Farmer may contain various salts, solids and cellulosic materials, which would "inherently" provide fluid loss control (see page 3, paragraph No. 4). Applicant disagrees. Reviewing the passage relied on by the examiner carefully reveals that Farmer states that "the gelling agents can be **absorbed onto the surface of non-reactive dispersible solids** to be used in the form of a flowable powder which ... **imparts desired viscosity** or rheology characteristics." (Emphasis Ours.) Clearly, this has nothing to do with fluid loss control as the solids are chosen for their ability to absorb the viscoelastic of Farmer and impart the desired viscosity when added to water or brine. And, since controlling fluid loss is a very specific method and technique, it is improbable, if not doubtful that the fluids of Farmer would provide any meaningful minimization of fluid loss.

In view of the foregoing applicants respectfully submit that the present rejection under **35 U.S.C. §102(e)** is clearly improper; reconsideration and withdrawal thereof is respectfully requested.

II. The Rejection of Claims 1 and 6 Under 35 U.S.C. §103(a) Over Farmer.

Applicant respectfully submits that the claimed method is not rendered obvious by Farmer.

Farmer discloses viscoelastic surfactants and various uses of same including drilling, hydraulic fracturing, permeability modification of underground formations, gravel packing, and cementing. Farmer does not disclose the claimed **method for controlling the fluid loss** in a subterranean formation

The claimed method comprises **treating** said subterranean formation with a viscoelastic treating fluid, wherein said fluid further comprises **a salt or solid**; and mixtures thereof. The specifics of this treating fluid and/or method are clearly not disclosed. In fact, as previously mentioned, in the passage relied on by the examiner

(page 3, paragraph No. 4 of the action) Farmer merely discloses that "the gelling agents can be **absorbed onto the surface of non-reactive dispersible solids** to be used in the form of a flowable powder which ... **imparts desired viscosity** or rheology characteristics." (Emphasis Ours.) This has nothing to do with the very specific method of fluid loss control as the solids are chosen for their ability to absorb the viscoelastic of Farmer and impart the desired viscosity when added to water or brine.

Finally, with fluid loss control, one is trying to **lower formation permeability** in order to prevent the liquid phase of the drilling fluid, slurry, or treatment fluid from entering the formation matrix, i.e., this is a **plugging mechanism**. Farmer, on the other hand, is primarily concerned with permeability modification. **Permeability modification is a diversion mechanism** whereby preferential flow of a particular fluid to a particular zone in the formation is desired. Accordingly, applicant respectfully submits that the examiner's statement is incorrect and inaccurate.

In summary, Farmer discloses certain viscoelastic surfactants, but does not disclose a method for controlling fluid loss. Applicant is claiming a very specific and new **method for controlling the fluid loss** in a subterranean formation, thereby minimizing the potential damage to the formation caused by said fluid loss. This method may, or may not, include viscoelastic surfactants disclosed by Farmer. Absent additional evidence in support of the rejection, Farmer's disclosure of viscoelastic surfactants that can possibly be utilized in applicant's method clearly does not render applicant's **method of use** unpatentable. In this regard, case law has clearly held that a "new" use for an "old" composition can be patented.

In view of the foregoing applicant respectfully submits that the examiner has failed to support a prima facie case of obviousness. Accordingly, applicant respectfully submits that one of ordinary skill in the art would not consider the claimed method to be obvious over the disclosure of the cited art. Therefore, the

present rejection is believed to be improper; reconsideration and withdrawal thereof is respectfully requested.

III. The Rejection of claims 1, 4, 7 and 9 Under 35 U.S.C. §112, First Paragraph

Initially, it is clear that the PTO has the *initial burden* of establishing that applicant has failed to comply with the written description requirement. Furthermore, it is sufficient that the specification "convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed." See, e.g., In re Wertheim, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976).

In the present situation, applicant made two inadvertent mistakes in General Formula I:

First, R' should have been defined as including hydrogen as a possible substituent, and

Second, the chain length for the R substituent should be from 8 to 27 carbon atoms (not 8-24).

In support of the requested changes, applicant relies on the disclosure of TAPAO, a preferred specie disclosed in the present application. TAPAO includes R' as **hydrogen**, and when R is an alkylamido group and TAPAO is contemplated, it is clear that the molecule can have, and does have **27 carbons** in the R substituent. It is also quite clear that applicant intended to include TAPAO in the General Formula I. More specifically, at the bottom of page 3 of the specification and on to page 4, applicant defines General Formula I, and in **THE SAME PARAGRAPH**, applicant states that a particularly preferred amine oxide gelling agent is tallow amido propylamine oxide (TAPAO). Thus, not only is TAPAO a disclosed specie within General Formula I, ...it is the preferred specie! Unfortunately, due to drafting mistakes, this preferred specie was inadvertently not covered by General Formula I.

It is applicant's position, however, that the aforementioned disclosures clearly convey to those skilled in the art that applicant has invented the specific subject

matter that they are seeking in correcting General Formula I. As such, and according to In re Wertheim, correction of General Formula I clearly does not run afoul of the written description requirement of §112, First Paragraph.

In the event that this rejection is maintained, the examiner is respectfully requested to accurately and concisely frame the issues for Appeal.

In view of the amendments and remarks herein, all of the pending claims are believed to be in condition for allowance, which action is respectfully solicited.

Respectfully submitted,

Ralph J. Mancini
Attorney for Applicant
Registration No. 34,054

Akzo Nobel Inc.
Intellectual Property Dept.
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408
(914) 674-5465